

**REMARKS**

Claims 1-30 and 32 are pending in this application. Claim 31 has been canceled without prejudice or disclaimer to the content therein, for the sole purpose of advancing prosecution. Claims 1-23 were withdrawn from consideration by the Examiner following a restriction with traverse. Claims 24-32 have been rejected.

Applicant, by amending or canceling any claims, makes no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicant reserves the right to reassert the original claim scope of any claim, even if amended or canceled, in a continuing application.

Claims 24, 27 and 29 have been amended to clarify the claimed subject matter; claim 32 has been amended to revise the dependency from canceled claim 31 to pending claim 24. Support for the claims as amended appears throughout the specification and claims as originally filed, for example, at least on page 6, lines 19 and 20 of the original specification as filed. It is respectfully submitted that the amendments do not introduce any new matter within the meaning of 35 U.S.C. §132. In view of the following, further and favorable consideration is respectfully requested.

***I. At pages 2 and 3 of the Office Action, claims 24-32 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.***

The Examiner rejected claims 24-32 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner asserted that “the term ‘relatively wide’ in claim 27 is a relative term which renders the claim indefinite”; “‘snugly’ in claim 24 renders the claim indefinite”; “Claim 29 recites the limitation ‘the rigid core.’ There is insufficient antecedent basis”; and “‘thin’ in claim 31 is a relative term which renders the claim indefinite.”

As discussed above, claim 31 has been canceled without prejudice or disclaimer; accordingly the rejection thereto is moot. Claims 24, 27 and 29 have been amended; the rejected terms have been deleted from the claims and claim 29 recites "the mold core." Accordingly, Applicant respectfully traverses the rejection and requests withdrawal of this rejection and continued examination. Applicant requests that Applicant's Representative be contacted should any issues remain unresolved.

***II. At pages 3-6 of the Office Action, claims 24-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,053,126 to Duret et al.***

The Examiner has rejected claims 24-32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,053,126 to Duret et al. (hereinafter referred to as "Duret et al.").

In view of the following, the remaining rejections are respectfully traversed. To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See *Dystar Textilfarben GMBH v. C. H. Patrick*, 464 F.3d 1356 (Fed. Cir. 2006). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 1366.

Overview

Claims 25-30 and 31 depend from claim 24. Independent claim 24 recites manufacturing a composite article comprising a metal reinforcing element and molded plastic coating firmly attached thereto, wherein the reinforcing element is formed to define an open channel having a longitudinal axis and an open side parallel to the axis, and the plastic coating includes a portion formed as a wall mechanically closing the open side of the channel, where the form of the metal reinforcing element allows insertion, via the open side of the channel, of a mold core which is configured to provide mechanical stability to the reinforcing element, the manufacturing comprising:

- providing the metal reinforcing element;
- providing the mold core;
- providing a mold comprising at least two parts formed to define a mold cavity therebetween when the mold is assembled, the mold being adapted to accommodate the metal reinforcing element fixedly in the mold cavity, allowing space for the plastic coating;
  - *inserting the mold core in the metal reinforcing element via the open side, so that the mold core provides mechanical support to the element;*
- assembling the mold parts and the metal reinforcing element with the inserted core therein so as to fix the reinforcing element in the mold cavity;
- injecting flowable and settable plastic coating into the space to form the composite article;
- releasing the obtained article including the reinforcing element, the set plastic coating and the mold core, by disassembling the mold; and
  - *removing the mold core from the article in a direction along the channel axis.*

Emphases added.

Rejection of claims 24-32

As discussed above, claim 31 has been canceled without prejudice or disclaimer; accordingly the rejection thereto is moot.

It is submitted that, with respect to the pending claims, a proper case of *prima facie* obviousness has not been established because, whether taken alone or together, none of the cited references teach or suggest all the limitations of the claims as required by *In re Wilson*. In view of the following, Applicant respectfully traverses this rejection.

Duret et al. fails to teach or suggest each and every element of the claims. Applicant respectfully submits that the Examiner's assertions regarding features of claim 24 fail to remedy the deficiencies of Duret et al.

The Examiner has cited Duret et al. col. 4, lines 49-59 as disclosing the "mold core" of the instant application. However, Applicant notes that these lines state that "[t]o protect them from a coating of synthetic material, the parts of the profile which are to remain bare are *coated* with a thermal screen" (emphasis added). Applicant assumes the Examiner regards the *coating* of Duret et al. as a 'mold core.' However, Applicant respectfully submits that a "mold core," even under the broadest possible interpretation, cannot be considered a "coating". Accordingly, at least the claim features of "*inserting the mold core in the metal reinforcing element via the open side, so that the mold core provides mechanical support to the element*" and "*removing the mold core from the article in a direction along the channel axis,*" both referencing a mold core, are not disclosed, taught or suggested by Duret et al.

Additionally, claim 24 recites that the mold core "provides mechanical support to the [reinforcing] element." Applicant respectfully submits that the asserted coating of Duret et al. cannot be a mold core as claimed, at least because the coating also does not provide any "mechanical support."

Further, claim 24 recites that the mold core is *inserted and removed*. This recitation further confirms that the "coating" element of Duret et al. cannot be a "mold core," as claimed, since one does not "insert" a coating. The Examiner has asserted on page 5 of the Office Action that Duret et al. also discloses "removing the mold core from the article" (col. 4 ,lines 49-59" and is deficient only in being "silent as to the direction of inserting or removing the mold core." Applicant respectfully disagrees, and submits that assuming *arguendo* that one would consider the coating of Duret et al. to be a mold core, Duret et al. still fails to disclose either insertion, or removal of a mold core. Thus, the claimed features are simply not disclosed in Duret et al.

There is also no motivation given in Duret et al. to remove the coating. Applicant notes that in contrast, an extra manufacturing step of removing the coating, which is not mentioned or even hinted to in Duret et al., would inevitably increase costs involved in the manufacturing process. Absent a clear need for such removal and increased costs, Applicant respectfully submits that such an additional step is extraneous and not obvious.

Finally, the pending claim even specifies a specific type of removal of the mold core "in a direction along the channel axis." Even if, assuming *arguendo*, one could consider the coating of Duret et al. to be a "mold core," and, assuming *arguendo*, one would find some reason to incur the additional cost of removing the coating, it would also not be obvious to also remove a "coating" in a particular direction, and especially in the specific direction

claimed. Absent disclosure of insertion or removal, there can also be no disclosure of a *direction* of insertion or removal.

In view of the foregoing, Applicant respectfully submits that nothing in the cited art references renders the presently claimed subject matter obvious within the meaning of 35 U.S.C. §103(a). Therefore, Applicant respectfully submits that claim 24, and claims 25-30 and 32 dependent therefrom are non-obvious, novel and patentable over the cited prior art, an indication of which is kindly requested. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 24-32.

**CONCLUSION**

Applicant asserts that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicant's undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicant hereby petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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